

REMARKS

Claims 1-9 are currently pending in the present application. Claims 1-3 are withdrawn from consideration and claims 4-19 are rejected.

No new matter has been added by way of the present submission. For instance, claim 1 has been amended to depend upon claim 4, thus allowing for rejoinder of claims 1-3 as discussed further below. Further, claims 4 and 5 have been amended to delete reference to "large." Lastly, claims 4 and 5 have been amended to clarify that "the ratio C/D of C to D is in the range of 0.7 to 1.5, and the ratio C^1/C^2 of C^1 to C^2 is in the range of 0.7 to 1.5," which is considered to have the same meaning as "the ratio C^1/D of C^1 to D is in the range of 0.7 to 1.5 and the ratio C^2/D of C^2 to D is in the range of 0.7 to 1.5," but is more clear and has been discussed with the Examiner as being correct. These amendments to claims 4 and 5 are non-narrowing in nature. Lastly, claims 10-19 have been cancelled. Thus, no new matter has been added.

In view of the following remarks, the Examiner is respectfully requested to withdraw all rejections and allow the currently pending claims.

Interview conducted on August 27, 2009

Applicants take this opportunity to thank the Examiner as well as the Examiner's Supervisor for the courtesies extended during the interview conducted on August 27, 2009. During the interview the main topic of discussion was the "new matter" rejection as well as caselaw that Applicants submit is in support of their position that there exists no issues of new matter.

Issues under 35 U.S.C. § 112, first paragraph

Claims 4-19 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This is a “new matter” rejection, which is respectfully traversed by Applicants.

Applicants respectfully traverse these rejections.

The Examiner has rejected the recently added claim language as constituting “new matter” (paragraphs 3, 5 and 6 of the Office Action). The disputed claim language is separated by paragraphs (A)-(G) at pages 4-6 of the Office Action, and each paragraph is discussed separately below.

- (A) The porous film has an average surface pore size A of 0.7 to 10 μm (claims 4, 10); has an average pore size A¹ of 0.7 to 10 μm at one surface, an average pore size A² of 0.7 to 10 μm at the other surface (claims 5, 11)

The Examiner contends that the value of 0.7 μm is just one value taken from Table 1-1 (page 30) of the specification which only applies to one example (Example 2). However, this does not require a “new matter” rejection. Applicants submit that those of skill in the art would understand that Applicants were in possession of such subject matter at the time of filing. In fact, the issue appears to be that the Examiner does not believe that Applicants can create ranges having endpoints that are derived from certain values exemplified in tables of the present specification. Applicants submit that such practice is perfectly acceptable. The Examiner’s attention is directed to the following caselaw, which supports this position.

“The failure to have specific examples in the specification does not make the written description as inadequate and failing to satisfy the requirements of 35 U.S.C. § 112, first paragraph. As stated by the Federal Circuit in *Falkner v. Inglis*:

A claim will not be invalidated on section 112 grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language. That is because the patent specification is written for a person of skill in the art, and such a person comes to the patent with the knowledge of what has come before. Placed in that context, it is unnecessary to spell out every detail of the invention in the specification; only enough must be included to convince a person of skill in the art that the inventor possessed the invention and to enable such a person to make and use the invention without undue experimentation.

79 USPQ2d 1001, 1007 (Fed. Cir.2006) (citing *LizardTech, Inc. v. Earth Resource Mapping, PTY, Inc.*, 424 F.3d 1336, 1345, 76 USPQ2d 1724, 1732 (Fed. Cir. 2005)).”

Indeed, the Examiner’s analysis must take into account which ranges one skilled in the art would consider inherently (and even explicitly) supported by the discussion in the original disclosure. The Examiner is additionally requested to consult the decision in *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). At issue in *Wertheim* was whether the claim limitation of "between 35% to 60%" by weight of coffee solids constituted “new matter.” The specification recited a range of 25% to 60% and exemplified processes using 36% and 50% solids.

The court concluded that

[i]n the context of this invention, in light of the description of the invention as employing solids contents within the range of 25-60% along with specific embodiments of 36% and 50%, we are of the opinion that, as a factual matter, persons skilled in the art would consider processes employing a 35- 60% solids content range to be part of appellants' invention.... The PTO has done nothing more than argue lack of literal support, which is not enough.

Similarly, in *In re Blaser*, 194 USPQ 122, 126 (CCPA, 1977) the claims recited "heating the reaction blend ... obtained after completing of said mixing to 80° C to 200° C.” The specification disclosed initially mixing the starting materials (at temperatures of up to 80° C) and then heating the reaction blend to temperatures between 60° C and 200° C. The court framed the

issue as "whether the disclosed range of 60° C to 200° C in [the specification] supports the recitation of 80° C to 200° C in the claims on appeal."

Appellants in *Blaser* relied on the rationale of *In re Wertheim*, *supra*, as "clearly applicable here." Appellants urged that if a disclosure of 25-60% solids content taught those skilled in the art that 35-60% was part of the invention in *Wertheim*, although the latter range was not expressly mentioned therein, then appellants' disclosure of 60° C to 200° C in the specification would likewise teach 80° C to 200° C as part of appellants' invention. The *Blaser* court agreed with appellants and found that the range of 80° C to 200° C was not new matter.

Also at issue in *Blaser*, was whether the phrase "said share of said water in said mixture is from 1.2 to 1.6 mols" had support in a parent case U.S. Serial No. 159,159. If this range did not have support, it would be new matter to the present application and claim 12 would not have the benefit of priority back to the filing date of the parent case. The court noted that in the parent application, there was a range with an upper limit of 1.6 mols which was expressly disclosed and examples 1-6 therein encompassed the range of 1.2 to 1.5 mols. The court found that, "[a]s a factual matter, persons skilled in the art would consider processes employing 1.2 to 1.6 mols water as part of appellants' invention and would have been led by U.S. Serial No. 159,159 so to conclude."

Respectfully, in the present case, the Examiner has done no more than to argue lack of literal support, which is not enough. *In re Lukach*, 169 USPQ at 796, (CCPA 1971), holds that for a proper rejection based on new matter, the Examiner not only has the burden of showing that the claimed invention is not literally described in the specification, but also the Examiner has the burden to give reasons why there is not implicit written description support.

Indeed, in the present instance, it can be seen that original claim 4 recited an average surface pore size A of "0.01 to 10 μm ." This range is also supported by the present specification at page 11, lines 7-10. Indeed, a preferred range of 0.05 to 5 μm is disclosed at page 11 of the specification as filed. Thus, just as the general range of "between 25% to 60%" by weight of coffee solids" was supported in the *Wertheim* case, so too is the general range of an average surface pore size A of "0.01 to 10 μm " supported by the present specification as filed.

Applicants have amended the average surface pore size A to recite a narrower range of "0.7 to 10 μm ." The value of 0.7 μm is exemplified in Table 1-1 (page 30) of the specification, see Example 2. The Examiner contends that this introduces "new matter." However, in the *Wertheim* case, the specification exemplified processes using 36% and 50% by weight of coffee solids. Remembering that the general range of "between 25% to 60%" by weight of coffee solids" was clearly supported in *Wertheim*, the Court found it allowable to create a new range, which was "35% to 60%." The fact that "36%" was exemplified was sufficient for the Court in *Wertheim* to find that the next adjacent number ("35%") was likewise supported by the application as filed.

The facts of the present case are clearly analogous to *Wertheim* since Applicants are creating a lower endpoint "0.7 μm " from an exemplified data point provided in the specification as filed. In fact, the present facts are more favorable than *Wertheim* since Applicants are not claiming the next adjacent data point (e.g., "0.6 μm "), but rather the exemplified data point (i.e., "0.7 μm ") itself. This is clearly sufficient written description for the presently claimed range.

Thus, based on the above-cited caselaw, it is proper to find sufficient support for the range noted in the title of (A) above. In fact, this caselaw provides the basis for reconsideration and withdrawal of all rejections based upon “new matter” including those discussed below.

(B) An average surface porosity C of from 50% to 80% (claims 4-5, 10-11)

Page 12 of the specification as filed supports an average surface porosity of 30% to 80%, 40% to 80% and 45% to 80%. Each of these ranges is analogous to the general range of “25% to 60%” of the *Wertheim* case discussed above. Next, it can be seen that Table 1-1 at page 30 exemplifies the “50%” recited in the present claims. This is clearly analogous to the exemplified “36%” and the claimed “35%” of the *Wertheim* case discussed above.

Thus, for the same reasons as discussed above under (A), this limitation is also supported by the specification as filed. The fact that this limitation has been combined with the limitation of (A) is irrelevant since the caselaw makes no restriction on the number of limitations that may be created from combinations of general ranges and specific examples.

(C) A maximum inside pore size is 5.1 μm or less (claims 4-5)

Page 11 of the specification as filed supports a range of maximum inside pore size of 15 μm or less. This range is analogous to the general range of “25% to 60%” of the *Wertheim* case discussed above. Next, it can be seen that Table 1-1 at page 30 supports the “5.1 μm ” recited in the present claims. This is analogous to the exemplified “36%” and the claimed “35%” of the *Wertheim* case discussed above.

Thus, for the same reasons as discussed above under (A) and (B), this limitation is also supported by the specification as filed. The fact that this limitation has been combined with the

limitations of (A) and (B) is irrelevant since the caselaw makes no restriction on the number of limitations that may be created from combinations of general ranges and specific examples.

- (D) The average surface porosity C has an average porosity C^1 of from 50% to 80% at one surface and an average porosity C^2 of from 50% to 80% at the other surface (claims 4-5, 10-11)

The same argument as discussed above for (B) is applicable to this (D) section.

- (E) The ratio C^1/D of C^1 to D is in the range of 0.7 to 1.5 and the ratio C^2/D of C^2 to D is in the range of 0.7 to 1.5 (claims 4-5)

As discussed with the Examiner during the Interview conducted on August 27, 2009, this limitation has been amended to recite "the ratio C/D of C to D is in the range of 0.7 to 1.5, and the ratio C^1/C^2 of C^1 to C^2 is in the range of 0.7 to 1.5." This term for amendment is considered to have the same mean as the term "The ratio C^1/D of C^1 to D is in the range of 0.7 to 1.5 and the ratio C^2/D of C^2 to D is in the range of 0.7 to 1.5." Applicants submit that both limitations are supported, but defer to the Examiner's preference for the limitation as submitted herewith.

- (F) The average inside pore size B is from 0.5 to 16.7 μm (claims 10-11)

Claims 10 and 11 have been cancelled, thus, this issue is moot.

- (G) The average porosity C^1 and C^2 values (claims 12-19)

Claims 12-19 have been cancelled, thus, this issue is moot.

In view of the above, Applicants submit that there exists no "new matter." Rather, those of skill in the art would have understood that Applicants were in possession of the invention as claimed at the time of filing.

Issue under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 4-19 under 35 U.S.C. § 112, second paragraph for reciting "large" in the phrase "a large number of continuous micropores" that appears in the preamble of the claims. Claims 4 and 5 have been amended to delete "large." Thus, this issue is moot. Reconsideration and withdrawal of the rejection are requested.

Rejoinder

Claim 1 has been amended to recite "A method for producing a porous film according to claim 4, comprising ...". The porous film of claim 4 is novel and non-obvious over the prior art, and thus, is a special technical feature of the present invention. Unity of invention determinations in the present application as an international application thus exists in the present invention. Therefore, claims 1-3 should be allowable and rejoined.

In view of the above, Applicants believe that the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Craig A. McRobbie, Reg. No. 42,874, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

f By  #42-874

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